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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,118	02/24/2000	Reuven Wachtfogel	NDS-4000 USA	7680

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Welsh & Katz, Ltd.
120 South Riverside Plaza
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Chicago,, IL 60606

EXAMINER
TRAN, HAI V

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/515,118	Applicant(s) WACHTFOGEL ET AL.	
	Examiner Hai Tran	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-106 is/are pending in the application.
- 4a) Of the above claim(s) 1-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 25-106 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Revised Amendment Practice 37 CFR 1.121 filed on or after July 30, 2003

Applicant is encouraged to follow instructions and examples for preparing further amendment document in order to avoid any inconvenient. A sample amendment document, questions and answers, and other information on the practice are posted on the USPTO website:

[http://www.uspto.gov/web/offices/pac/dapp/opala/preognotice/moreinfoamdtprac.
htm](http://www.uspto.gov/web/offices/pac/dapp/opala/preognotice/moreinfoamdtprac.htm)

Preliminary Amendment

Preliminary amendment dated 12/17/2001 has been entered, thus the restriction requirement from the previous Office Action were withdrawn.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 35-53, drawn to a system to encode tags/decode tags to/from program material being broadcasted/received, classified in class 725, subclass 31.
- II. Claims 54-69, 77 drawn to Recording with Quality Level, classified in class 386, subclass 46.
- III. Claims 70-76, drawn to Commercial based on User profile/history, classified in class 725, subclass 34.

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- IV. Claims 78-83 and 90 drawn to Recording/Playback base on user rating, classified in class 386, subclass 83.
- V. Claims 84-89, drawn to Broadcasts/receives browsable program structure in VOD environment, classified in class 725, subclass 88.
- VI. Claim 91-93, drawn to Operation of a receiver with a particular storage and control access for recording/playback function, classified in class 386, subclass 68.
- VII. Claim 94-16 draw to method of booking/purchasing a pay TV program, classified in class 725, subclass 1 and in class 705, subclass 26-27.

Inventions II, III, IV, V, VI, VII and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because

1. The detail of the broadest sub-combination claim 54, such as "...and recording said program material at selectable quality level" of Group II is not recited in the broadest combination claim 35 of Group I, claim 70 of Group III, claims 78 and 90 of Group IV, claims 84 and 88 of Group V, claim 91 of Group VI, and claims 94 and 99 of Group VII.

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2. The detail of the broadest sub-combination claim 70, such as "...and including a commercial unit for dealing with said commercials based at least partially on past viewing thereof" of Group III is not recited in the broadest combination claim 35 of Group I, claim 54 of Group II, claims 78 and 90 of Group IV, claims 84 and 88 of Group V, claim 91 of Group VI, and claims 94 and 99 of Group VII.
3. The detail of the broadest sub-combination claims 78 and 90, such as "...deciding whether to record a program pursuant to a recording determination; and determining whether to play a program pursuant to a play determination based on a program rating" of Group IV is not recited in the broadest combination claim 35 of Group I, claim 54 of Group II, claim 70 of Group III, claims 84 and 88 of Group V, claim 91 of Group VI, and claims 94 and 99 of Group VII.
4. The detail of the broadest sub-combination claim 84, such as "...broadcasting program material with a browsable program structure...a receiver browser for browsing said program material at least in accordance with said browsable program structure" and claim 88, such as "... with a program structure including non-user view controllable portion...a receiver-decoder browser for enabling user view control of said program material other than said non-user view controllable portion thereof" of Group V is not recited in the broadest combination claim 35 of Group I, claim 54 of Group II, claim 70 of Group III, claims 78 and 90 of Group IV, claim 91 of Group VI, and claims 94 and 99 of Group VII.

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5. The detail of the broadest sub-combination claim 91, such as "...a circular buffer...a conditional access module for providing conditional access to the program stored in the circular buffer; and...upon receiving a freeze indication via an input apparatus, ... to record the program in the circular buffer from a moment of receiving the freeze indication, and upon receiving a play indication via the input apparatus, ...to play the program recorded in the circular buffer from the moment of receiving the freeze indication in accordance with conditions determined by the conditional access module" of Group VI is not recited in the broadest combination claim 35 of Group I, claim 54 of Group II, claim 70 of Group III, claims 78 and 90 of Group IV, claim 84 of Group V, and claims 94 and 99 of Group VII.
6. The detail of the broadest sub-combination claim 94, such as "a method for booking or purchasing a pay television program..., allowing a booking or purchasing request for the pay program to be made" of Group VII is not recited in the broadest combination claim 35 of Group I, claim 54 of Group II, claim 70 of Group III, claims 78 and 90 of Group IV, and claim 84 of Group V and 91 of Group VI.

The subcombination has separate utility such as

- The subcombination Group II has separate utility apart from distributing encoded television program, commercial distribution within the broadcast television of Group I, from targeting commercials to users of group III, from

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recording and playback video program based on rating of group IV, from video-on-demand distribution of group V, from video receiver with particular storage and control access function of group VI, and from a presentation of image or description of sale in a video distribution system of Group VII such as, recording video program with quality level.

- The subcombination Group III has separate utility apart from distributing encoded television program, commercial distribution within the broadcast television of Group I, from recording video program with quality level of group II, from recording and playback video program based on rating of group IV, from video-on-demand distribution of group V, from video receiver with particular storage and control access function of group VI, and from a presentation of image or description of sale in a video distribution system of Group VII such as, targeting commercials to users.
- The subcombination Group IV has separate utility from distributing encoded television program, commercial distribution within the broadcast television of Group I, from recording video program with quality level of group II, from targeting commercials to users of group III, from video-on-demand distribution of group V, from video receiver with particular storage and control access function of group VI, and from a presentation of image or description of sale in a video distribution system of Group VII such as, recording and playback apparatus of video program based on rating.
- The subcombination Group V has separate utility from distributing encoded television program, commercial distribution within the broadcast television of

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Group I, from recording video program with quality level of group II, from targeting commercials to users of group III, from recording and playback video program based on rating of group IV, from video receiver with particular storage and control access function of group VI, and from a presentation of image or description of sale in a video distribution system of Group VII such as, video-on-demand distribution.

- The subcombination Group VI has separate utility from distributing encoded television program, commercial distribution within the broadcast television of Group I, from recording video program with quality level of group II, from targeting commercials to users of group III, from recording and playback video program based on rating of group IV, from video-on-demand distribution of group V, and from a presentation of image or description of sale in a video distribution system of Group VII such as, video receiver with particular storage and control access function.
- The subcombination Group VII has separate utility from distributing encoded television program, commercial distribution within the broadcast television of Group I, from recording video program with quality level of group II, from targeting commercials to users of group III, from recording and playback video program based on rating of group IV, from video-on-demand distribution of group V, and from a video receiver with particular storage and control access function of Group VI such as, presentation of image or description of sale in a video distribution system.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, as shown by their different classification and their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

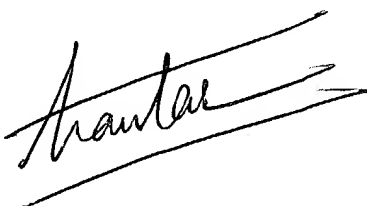
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is 703-308-7372. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HT:ht
10/27/2004

A handwritten signature in black ink, appearing to read "HAITRAN", is written over two horizontal lines.

HAITRAN
PATENT EXAMINER